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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,598	02/11/2002	Nicole Beaulieu	IGT1P530/P000576-001	5942
79646 7590 12/21/2009 Weaver Austin Villeneuve & Sampson LLP - IGT Attn: IGT P.O. Box 70250 Oakland, CA 94612-0250			EXAMINER MOSSER, ROBERT E	
			ART UNIT 3714	PAPER NUMBER
			NOTIFICATION DATE 12/21/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@wavsip.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/073,598	<b>Applicant(s)</b> BEAULIEU, NICOLE	
	<b>Examiner</b> ROBERT MOSSER	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/09/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 9<sup>th</sup>, 2009 has been entered.

### ***Information Disclosure Statement***

The information disclosure statement entered December 9<sup>th</sup>, 2009 has been considered. A copy of the cited statement including the notation indicating its respective consideration is attached for the Applicant's records.

### ***Affidavit submitted under 37 CFR 1.131***

The affidavit filed on July 23, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Joshi (USP 6,485,367) reference.

A. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Joshi (USP 6,485,367) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and

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their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

I. The affidavit and attached evidence fails to demonstrate a correlation between the claimed invention, and the evidenced disclosure of the invention. The attached exhibits instead presents a general concept of employing a quick pick type feature as found in Keno in other type of selection environments and are silent to the exemplary feature of the utilization of game rules in making an automated selection according to the optimal strategy.

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. In re Tanczyn, 347 F.2d 830, 146 USPQ 298 (CCPA 1965). (MPEP 715.02)

B. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Joshi (USP 6,485,367) reference to either a constructive reduction to practice or an actual reduction to practice.

I. From April of 2001 till November of 2001 there is no accounting for diligence. Specifically there exists a 7 month period during which the written description of the invention was forwarded to the applicant's representative and the applicant's representative presented the initial draft of the application that has not been accounted for. (MPEP 2138.06). The applicant must account for the relevant time at least from before the July 27, 2001 date of Joshi to the filing of the application.

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Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. (MPEP 715.07(a))

II. The Affidavit submitted under 1.131 includes addition multiple lapses of continuity from the date of July 27, 2001 to the constructive reduction of practice and according fails to establish diligence (See element .B.I. above).

III. Work relied upon to demonstrate diligence must be directly related to the reduction to practice of the invention in issue (MPEP 2138.06). It is unclear how items 8, 12, and 13 directly relate to the constructive reduction of practice of the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41, and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), and Bennett '178 teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10<sup>th</sup>, 2008 incorporated herein by reference however the Board decision is silent regarding the amended features directed *to the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout* and wherein responsive to a player request the automated selection system is programmed to make a selection from unselected game options after a person has executed a selection of the one or more options

The above referenced feature directed to the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout is however is taught by the reference of Joshi (Figure 7, Col 8:56-9:18) with particular reference to the identification

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of outcome probability and the indicated selection of elements with the greatest probability of a winning outcome. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the optimized auto-selection feature of Joshi into the combination of Bennett '102 , Appellant's Admitted Prior Art , and Bennett '178 in order to enable the player to select a default selection of the Applicant's admitted prior art without sacrificing optimal game actions.

The above referenced and newly claimed feature providing that responsive to a player request the automated selection system is programmed to make a selection from unselected game options after a person has executed a selection of the one or more options, provides the steps of the applicants admitted prior art (pages 1 and 2 of the applicant's specification) in combining automated selections with player selections. As best understood the applicant's proposed separation between the prior art and the claimed invention would rest on the order of execution and in particular that the player selection precedes the step of automated selection rather than follows it. The mere re-ordering of known method steps however is prima facie obvious (see MPEP 2144.04.IV.C). It would have been obvious to one of ordinary skill in the art at the time of invention to have included a player selection of game elements prior to an automated selection of elements in order allow participants to fill in their favorite or lucky selections and allow the gaming device to populate the rest of the matrix thereafter and therewith adding an element of convenience in the selection process through ensuring the players

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favorite or lucky selection are included without enduring the burden of inspecting and adjusting automated selections to ensure the inclusion of favorite or lucky numbers.

Claims **4, 15, 36, and 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Mayeroff, and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Mayeroff teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10<sup>th</sup>, 2008 incorporated herein by reference.

Claims **10-11, and 21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Walker and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Walker teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10<sup>th</sup>, 2008 incorporated herein by reference.

### ***Response to Arguments***



Applicant's arguments filed December 9<sup>th</sup>, 2009 have been fully considered but they are not persuasive.

Commencing on page 10 the applicant challenges the rejection of declaration filed under Rule 131.

On a first note the applicant presents that the finding of insufficient evidence of conception is incorrect and offers in support elements of the declaration as originally submitted. None of the alleged support describes the exemplary feature of the utilization of game rules in making an automated selection according to the optimal strategy as previously presented, nor does it address the limitation directed to the order of player and machine selection now claimed. The applicant's arguments against the finding of insufficient evidence of conception are non-persuasive.

On the second note the applicant's challenges the finding of a lack of diligence in the noted seven month gap and characterizes the time period as a short gap. There is no support for such a characterization and nor does seven months reasonably represent a short gap as so characterized. The applicant's challenges against the finding of a lack of diligence are non-persuasive.

Continuing on page 11 the applicant's remarks challenge the rejection of record with primary emphasis on the prior art of Joshi.

On the 4th full paragraph of page 11 the applicant generally presents that the prior art of Joshi teaches the suggestion of a selectable option rather than the actual selection of the option. As recited in the rejection as presented above and as originally

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incorporated the prior art of Joshi is not relied upon for the step of making the selection as this has been previously address

With reflection of the above the applicant's arguments of the 4th full paragraph of page 11, propose that the prior art of Joshi teaches a suggestion of selection of game elements rather than an affirmative selection. Respectfully Joshi is not relied upon for the step of conducting an affirmative selection as this element has been provided for by the Patent Board Appeals in the decision rendered March 10<sup>th</sup>, 2008 as derived from the combination of the applicant admitted prior art , Bennett '102 and Bennett '178.

Continuing in the same paragraph the applicant argues the prior arts suggestion of selection is not limited to a subset of selectable elements excluding the plurality of elements previously selected by the player. However, it is noted that common to the applicant's admitted prior art system/method and the claimed system/method the player/participant's selection of the selectable game elements blocks the automated selection of those same game elements. Accordingly as the selection of game elements in an automated selection is blocked in both the applicant's admitted prior art and the applicant's claimed invention there is no support for the proposed separation based on this feature.

Commencing in the paragraph bridging pages 11 and 12 the applicant argues that the taught manner of manual selection responsive to a suggested selection Joshi teaches away from elements of an automated selection. The applicant's argument is based on the assertion that manual selection and a automated selection must be exclusive to one another and at the very least discourage use of the alternative

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selection method. However, the admitted prior art and even the applicant's pending claims recognize that player selection and automated selection of game may suitably coexist. As both the manual selection of game elements with the automated selection of different game elements suitably coexist in the prior art, the divergent path that would provide a fair and reasonable basis for a teaching away cannot be held as implicit to the nature of the combination. The remaining question for the proposed teaching away is if the reference of Joshi would in isolation discourage one of ordinary skill in the art at the time of invention from the utilization of an automated selection. Upon review of the prior art of Joshi, it is noted that Joshi does teach the automated and adaptive suggestion of elements for selection but does not explicitly recognize the automated selection and further that Joshi does not specifically disparage the use of automated selection. Accordingly while the prior art of Joshi does not specifically teach the affirmative automated selection of game elements in isolation it additionally fails to directly or indirectly discourage the use of automated selection. The applicant's arguments directed to a teaching away are respectfully non-persuasive.

Concluding in the first full paragraph of page 12 of the applicant's remarks, the applicant's presents that the prior art does not teach limiting the player selection to less than all of the elements and utilizing automated selection for the remaining elements. As noted above however, the applicant's admitted prior art teaches utilizing a player selection of elements for portion of the selectable elements and an automated selection for the remainder of the selectable elements. The order of the player and machine selections has been addressed in the above presented rejections.

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Based on the above, the rejection of record is maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/  
Supervisory Patent Examiner, Art  
Unit 3714

/R. M./  
Examiner, Art Unit 3714

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